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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,766	07/20/2005	Eiichi Kato	019519-482	1607
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EXAMINER NELSON, MICHAEL B				
ART UNIT 4145		PAPER NUMBER		
NOTIFICATION DATE 01/10/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com  
debra.hawkins@bipc.com

### Office Action Summary

**Application No.**

10/542,766

**Applicant(s)**

KATO, EIICHI

**Examiner**

MICHAEL B. NELSON

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/86)  
Paper No(s)/Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-13 and 27-29, drawn to products containing a high refractive index layer.

Group II, claim(s) 14-26, drawn to products containing a curable coating composition.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: While both inventions share the same high refractive index characteristics, the only specific limitation that are shared on this characteristic is that the high refractive index layer comprises fine particles of a high refractive index composite oxide and that the high refractive index composite oxide contain at least one metal element with an index of refraction of 1.95 or more. This limitation, though shared between all inventions does not define a contribution which each of the claimed invention, considered as a whole, make over the prior art because Suzuki et. al (U.S. 3,869,298) discloses a high refractive index coating comprising fine particles of high refractive index composite oxide (See C2, L53-63), where in said high refractive index composite oxide contains a metal element with an index of refraction of 1.95 or more (See C1, L45-57).

3. If, indeed, the applicant elects Invention I, a further restriction to the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1, is required:

Group Ia, claim(s) 1-6 and 27, drawn to a high refractive index layer.

Group Ib, claim(s) 7-9 and 28, drawn to an antireflective film.

Group Ic, claim(s) 10-12, drawn to a polarizing plate.

Group Id, claim(s) 13 and 29, drawn to an image display device.

4. The inventions listed as Groups Ia, Ib, Ic, and Id do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the high refractive index layer, though shared between all inventions does not define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art because Nitta et. al (U.S. 5,702,519) discloses fine particles of a high refractive index composite oxide containing a titanium element (See C1, L15-20) and another metal element with an index of refraction higher than 1.95 or more and wherein the composite oxide is doped with an Al ion (See C1, L15-24, the aluminum doped flaky iron oxide has an index of refraction of higher than 1.95). Nitta et. al also discloses using these particles in coatings to form layers (C5, L65- C6, L5).

5. If, indeed, the applicant elects Invention II, a further restriction to the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1, is required:

Group IIa, claim(s) 14-18, drawn to a process for producing a curable coating composition.

Group IIb, claim(s) 19, drawn to a cured film.

Group IIc, claim(s) 20-22, drawn to an antireflection film.

Group IId, claim(s) 23-25, drawn to a polarizing plate.

Group IIe, claim(s) 26, drawn to an image display device.

6. The inventions listed as Groups IIa, IIb, IIc, IId and IIe do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the curable coating composition, though shared between all inventions does not define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art because Beck et. al (U.S. 2,853,393) discloses fine particles of a high refractive index composite oxide containing bismuth and at least one metal with an index of refraction of 1.95 or more (See Table 1 and 2, C5, L35-65, Bismuth oxide is combined with Titanium oxide which has an index of refraction of more than 1.95). Furthermore, Suzuki et. al (U.S. 6,319,594) discloses high refractive index composite oxide fine particles with a particle diameter of 1 to 50 nm (See C6, L50-63), and uses these particles in a high refractive index coating composition (See Fig. 1, the hardcoat layer 3 contains the fine particles).

7. Applicant is required under 35 U.S.C. 121 and 372 to elect a single disclosed invention (either Ia, or Ib, or Ic, or Id, or IIa, or IIb, or IIc, or IId, or IIe) for prosecution on the merits to which the claims shall be restricted.

8. **Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined** even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

9. If applicant elects inventions Ib, or Ic, or Id, or IIc, or IId, or IIe, claims 7 and 8, or 10 or 13 and 29 or 20 or 23 and 24 or 26, respectively have to be rewritten in independent form.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

11. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. Failure to do so

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may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

*Conclusion*

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL B. NELSON whose telephone number is (571)270-3877. The examiner can normally be reached on Monday through Thursday 6AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Basia Ridley can be reached on (571) 272-1453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MN/

12/19/2007

/Basia Ridley/

Supervisory Patent Examiner, Art Unit 4145